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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,713	03/26/2004	Yo Tsurumi	59558.00025	8106

32294 7590 08/08/2005

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EXAMINER

LE, DAVID D

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/809,713	TSURUMI ET AL.	
	Examiner	Art Unit	
	David D. Le	3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/26/04</u> .                                                            | 6) <input type="checkbox"/> Other: _____                                    |

EA

### **DETAILED ACTION**

1. This is the first Office action on the merits of Application No. 10/809,713, filed on 26 March 2004. Claims 1-8 are pending.

### **Documents**

2. The following documents have been received and filed as part of the patent application:
  - Foreign Priority Document, received on 03/26/04
  - Information Disclosure Statement, received on 03/26/04

### ***Election/Restrictions***

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species A: Figs. 1-2; and
- Species B: Fig. 3.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with applicant's attorney, Arlene Neal, on 04 August 2005 a provisional election was made with traverse to prosecute the invention of Species A, claims 1-3 and 5-8. Affirmation of this election must be made by applicant in replying to this Office action. Claim 4 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claims 6-7:**

- Claim 6 recites the limitation "the output shaft". There is insufficient antecedent basis for this limitation in the claim.
- Claim 7 recites the limitation "the input shaft". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent Application Publication No. US 2002/0155915 to Tanaka.**

Claims 1-3 and 5-8:

Tanaka (i.e., Fig. 1; paragraphs [0013] to [0023]) discloses a speed reduction gear comprising:

- A driving source-end pinion (i.e., Fig. 1, element 30);
- An external gear (i.e., Fig. 1, element 19);
- An internal gear (i.e., Fig. 1, element 21) having a slight difference in the number of teeth with the external gear (i.e., paragraph [0018]);
- A plurality of eccentric shafts (i.e., Fig. 1, elements 17) oscillatingly rotating the internal gear;
- Eccentric shaft gears (i.e., Fig. 1, elements 17a and 17b) incorporated on the plurality eccentric shafts, respectively;
- A transmitting external gear (i.e., Fig. 1, element 33) concurrently and operatively meshing with the eccentric shaft gears and the driving source-end pinion;
- Wherein the transmitting external gear is formed in a ring shape, and is rotatably supported by an output shaft (i.e., Fig. 1, element 34);
- Wherein external teeth of the external gear are formed by external pins inserted freely rotatable in circular grooves thereof (i.e. paragraph [0018]);
- Wherein the internal gears are inherently incorporated in a number of two axially, and the transmitting external gear is located between any two internal gears thereof (i.e., Fig. 1)

- A middle shaft (i.e., Fig. 1, being the elongated portion of intermediate gear 30), on which the driving source-end pinion is incorporated, provided in parallel to the output shaft at a position radially outward of the internal gear; and
- Wherein a pinion (i.e., Fig. 1, element 25b) incorporated on an input shaft (i.e., Fig. 1, being the combination of elements 51 and 25) directly meshes with the driving source-end pinion.

### *Double Patenting*

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-3 and 5-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/809,935. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same structure with different nomenclatures. For example, the present claimed element, “a driving source-end pinion” is the claimed element, “a middle gear” of the above mentioned copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-3 and 5-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/803,102. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same structure with different nomenclatures. For example, the present claimed element, “an internal gear” is the claimed element, “an internal oscillating body” of the above mentioned copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



*Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Tanaka (U. S. Patent No. 6,699,152) discloses a speed reduction gear as shown in Fig. 1.
- Healy (U. S. Patent No. 4,426,064) teaches a winch drive mechanism as shown in Fig. 2.
- Mauletti (U. S. Patent No. 5,606,235) teaches an industrial robot with integrated reduction gear units as shown in Figs. 3-7.
- Japanese Patent No. JP02000065159A teaches an internal tooth rocking type inscribed meshing planetary gear device as shown in Fig. 6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ddl

*Charles A. Marmo 8/4/05*  
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